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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,873	03/16/2004	Masakatsu Kiwada	011350-329	1558
21839 7590 08/22/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER CRUZ, IRIANA	
			ART UNIT 2609	PAPER NUMBER
			MAIL DATE 08/22/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/800,873

Applicant(s)

KIWADA, MASAKATSU

Examiner

Iriana Cruz

Art Unit

2609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/16/2004
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-2, 5-8, 11-14 and 17-19** are rejected under 35 U.S.C. 102(b) as being anticipated by Teraura (U.S. Patent Number 6,827,279).

With regards to **Claims 1, 7, and 13**, Teraura discloses an image forming device (FIG. 2) comprising: a transporting unit for transporting a document sheet by sheet to a specified reading position; a judging unit (FIG. 6, A2) for judging whether a document transported by said transporting unit is an electronically tagged printed matter wherein image data is printed on an electronically tagged printing paper equipped with an electronic tag for storing electronic data in a certain part of the printing paper and said electronic tag stores image data printed on said electronically tagged printing paper (See Col.7, lines 5-10 and 46-50); a reading unit for reading the image data from the electronic tag of the document which is judged as said electronically tagged printing matter by said judgment unit; and a printing unit for printing the image data read by said reading unit (See Col.8, lines 25-27).

With regards to **Claims 2, 8, and 14** Teraura discloses an image forming device further comprising: a scanning unit for acquiring image data by scanning a document which is judged not as an electronically tagged printed matter by said judgment unit,

wherein said printing unit prints image data acquired by said scanning unit (See Col.7, lines 10-20).

With regards to **Claims 5, 11 and 17** Teraura discloses an image forming device wherein said printing unit prints image data on an electronically tagged printing paper equipped with an electronic tag for storing electronic data in a certain part of the printing paper, further comprising: a writing unit for writing the image data printed by said printing unit on the electronic tag of the electronically tagged printing paper on which the image data is printed by said printing unit (See Col.7, lines 46-51).

With regards to **Claims 6, 12 and 18** Teraura discloses an image forming device wherein said electronic tag transmits or receives electronic data by means of wireless communications (See Col.4. lines 22-24 and lines 48-54).

With regards to **Claim 19** Teraura discloses a computer readable recording medium on which the image forming program is recorded (Col.6, lines 50-53).

Claim Rejections - 35 USC § 103

3. **Claims 3, 9, and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (U.S. Patent Number 6,827,279) in view of Hopper (U.S. Patent Number 7,099,029).

In regard to **Claims 3, 9, and 15** Teraura teaches an image forming device that comprise a judging unit that judges if a document is an electronically tagged matter or a non electronically tagged matter. Teraura does not teach a printing unit that when judges a document as a non electronically tagged matter prints a blank paper.

However Hopper teaches a printing device where the media travels at fill speed forward and waits for encoded marks, when there is no encoded marks it prints blank paper (See Col.4, lines 46-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the image forming apparatus that judges if a document is an electronically tagged matter or not as taught by Teraura with printing a blank page when what is looked for in a document is not found as taught by Hopper in order to have an alternate printing method where the printer is specifically used for electronically tagged documents.

4. **Claims 4, 10, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Teraura (U.S. Patent Number 6,827,279) in view of Cherry et al. (U.S. Publication Number 2003/0151762 A1).

In regards of **Claims 4, 10, and 16** Teraura teaches an image forming device that comprise a judging unit that judges if a document is an electronically tagged matter or a non electronically tagged matter. Teraura does not teach a printing unit that when judges a document as a non electronically tagged matter prints no output.

However Cherry teaches a system that allows retrieving an authorization code and assigning it to a header of a print job. If the authorization code is valid, then the print job is sent to a printer. On the other hand, if the authorization code is invalid, then the print job is denied and no printing is authorized, which means there is no output from the printer (See Paragraph 5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the image forming apparatus that judges if a document is an electronically tagged matter or not as taught by Teraura with a system that prints no output as taught by Cherry in order to not print a document that does not comply with the restrictions needed to allow the printing.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iriana Cruz whose telephone number is (571) 270-3246. The examiner can normally be reached on Monday-friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Eisen can be reached on (571) 270-1455. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read 'Alexander Eisen', with a stylized, cursive script.

Alexander Eisen
SPE
Art Unit 2609

August 17, 2007